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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,142	04/16/2004	Joshua Lapsker	2834-1-003	8763
23565	7590	05/18/2005	EXAMINER	
KLAUBER & JACKSON 411 HACKENSACK AVENUE HACKENSACK, NJ 07601			JOHNSON, JERROLD D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,142

Applicant(s)

LAPSKER, JOSHUA

Examiner

Jerrold Johnson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 1 and 2 are objected to because of the following informalities: Claim 1 sets forth that the portable pill box is attached to the informational backing portion. Claim 2 recites affixed. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Weinstein US 2004/0140241.

Re claim 1, Weinstein discloses an informational backing portion 130, a portable pill box 130a attached to the informational backing portion; and a personalized information identifier (i.e. printed indicia) 134 affixed to the pillbox.

Regarding the printed indicia (the personalized information identifier) of this claim, and the specific recitations of the personalized information identifier set forth in claims 2-5, these recitations have been carefully considered but deemed not to impose

Art Unit: 3728

any limitations on the claims in that no new and unobvious functional relationship exists between the printed indicia and the remainder of the kit.

In the determination of whether the printed matter is functionally related to the kit, reference is made to the following two Federal Circuit decisions: *In re Gulack*, 703 F.2d 1381 [217 USPQ 401] (Fed. Cir. 1983), and *In re Ngai* 70 USPQ 2d 1862 (CA FC 2004).

Quoting *Gulack*, "The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 1386.

The CAFC determined that in *Gulack* there was not merely a functional relationship between the printed matter and the substrate, but that the printed matter and the substrate were functionally interrelated, and that there was a new and unobvious functional relationship between the substrate (the container) and the printed matter.

The CAFC stated within the *in re Ngai* decision "In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result." *Id.* at 1864.

In the present application, like *Ngai*, there is no new and unobvious functional relationship between the substrate (the container) and the printed matter. In *Ngai*, the court stated that "the printed matter in no way depends on the kit, and the kit does not depend on the printed matter." Similarly in the present application, the portable pill box

Art Unit: 3728

is suitable to perform the function of a portable pill box in the manner described in the specification irrespective of the printed matter.

Accordingly, as Weinstein does set forth printed matter, and as the content of the claimed printed matter is not deemed to confer any limitations to the claims, Weinstein anticipates these claims.

Re claim 6, note the packaged sample of prescription drug sample 121 that is affixed to the backing portion.

Re claims 7-12, these claims merely set forth the inherent process steps of making the kit of Weinstein.

Again, with respect to the recitations of the specific content of the printed matter within these claims, note the rejection of claims 1-5 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 3728

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lein US 6,758,338 in view of Lapsker US 5,908,208 and Fox, II (hereinafter "Fox") US 3,811,563.

Lein discloses a portable pill box 2, and a personalized information identifier 56 attached to the pillbox. Lein further discloses in Col. 8, lines 64-68, that the pillbox can be provided as added value on a package of medicine as a bonus feature. Lein further discloses the content of the personalized information identifier in col. 10, lines 2-16, which comprises emergency information, contact information of the prescribing doctor, dosage, etc. Lein discloses, by way of example, the use of aspirin, which is known to be prescribed by the medical community as an aid in certain medical conditions (heart attack). However, the pillbox of Lein is not limited to aspirin, and is suitable for containing any drug in pill form that may be required in an emergency. As evidence of this, in col. 1 Lein further mentions insulin, epinephrine, nitroglycerin, etc., as drugs that are needed in an emergency.

Fox discloses how a box like Lein can be disposed on a stiff packaging product.

Lapsker discloses a package of medicine comprising an informational backing portion 12 comprising a stiff packaging product that is imprinted with desired prescription drug information. Lapsker further discloses a packaged drug sample affixed to the backing portion.

Accordingly, as Lein has disclosed providing a portable pill box on a package of medicine, Fox teaches how portable boxes can be attached to a package, and Lapsker teaches packages of medicine which include drug samples, it would have been obvious to one of ordinary skill in the art to have provided the portable pill box of Lein on the informational backing portion of Lapsker so as to provide an added bonus when a doctor provides a patient a free sample of a prescription drug of a suitable container for a small number of doses of that pill.

It is noted that the pharmaceutical industry is well known to regularly provide added bonuses of many types.

With specific regard to the printed indicia (the personalized information identifier) of this claim, and the specific recitations of the personalized information identifier set forth in claims 2-5, it is first noted that Lein discloses a variety of emergency information including contact information for a doctor, dosage, etc. Additionally, these recitations have been carefully considered but deemed not to impose any limitations on the claims in that no new and unobvious functional relationship exists between the printed indicia and the remainder of the kit.

In the determination of whether the printed matter is functionally related to the kit, reference is made to the following two Federal Circuit decisions: *In re Gulack*, 703 F.2d. 1381 [217 USPQ 401] (Fed. Cir. 1983), and *In re Ngai* 70 USPQ 2d 1862 (CA FC 2004).

Quoting Gulack, "The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the

critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 1386.

The CAFC determined that in *Gulack* there was not merely a functional relationship between the printed matter and the substrate, but that the printed matter and the substrate were functionally interrelated, and that there was a new and unobvious functional relationship between the substrate (the container) and the printed matter.

The CAFC stated within the *in re Ngai* decision "In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result." *Id.* at 1864.

In the present application, like *Ngai*, there is no new and unobvious functional relationship between the substrate (the container) and the printed matter. In *Ngai*, the court stated that "the printed matter in no way depends on the kit, and the kit does not depend on the printed matter." Similarly in the present application, the portable pill box is suitable to perform the function of a portable pill box in the manner described in the specification irrespective of the printed matter.

Re claims 7-12, these claims merely set forth the inherent process steps of making the kit of *Lein* US 6,758,338 in view of *Lapsker* US 5,908,208 and *Fox*, II (hereinafter "*Fox*") US 3,811,563, and are obvious for the reasons stated above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lupi US 5,755,462 discloses a backing portion 12 with a re-usable pillbox 14, a packaged sample 28, etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ



Mickey Yu
Supervisory Patent Examiner
Group 3700

Application/Control Number: 10/826,142
Art Unit: 3728

Page 9